

### REMARKS/ARGUMENTS

Claims 2, 3 and 9, each relating to laundry additive compositions, have been cancelled herewith without prejudice to Applicants' right to pursue such claims in a continuation application. These claims have been cancelled solely to focus the issues in prosecution of the remaining claims onto detergent compositions which comprise anionic surfactants.

Claims 1, 4-8 and 10-18 are now in the case. Claim 1 has been amended to recite the 5% to about 70% range of the surfactant. Basis for the "about 70%" limit is at page 2, line 13, of the specification. (All page citations herein are to the PCT/US99/22935 document.) The 5% limit is at page 6, line 8. In further regard to the limits on the anionic surfactant, Claim 8 recites at least about 9% and Claims 15 and 18 each recite a range of about 9% to about 50%. The 50% limit is found at page 6, line 8. Examples listed at pages 23 and 25 show LAS in the 9.31 and 9.40 range. Accordingly, it is submitted that the "about 9%" limit is fully supported by the *Wertheim* case, discussed hereinafter.

Claim 7 has been amended to delete the recitation of "anionic" as redundant in view of the amendment of Claim 1. The "additional surfactant" language of amended Claim 7 is supported by the "mixtures thereof" disclosure at page 2, line 15, and by the various working examples, which employ mixtures of surfactants.

New Claims 15, 16, 17 and 18 are also fully supported by the specification. Support for the surfactant ranges recited therein are found at the pages noted above. Support for the alkyl benzene sulfonate recitation is at page 6, lines 25-27. Support for the alkyl ethoxy sulfate recitation is at page 6, lines 28-32.

Claim 1 has been further amended to disclaim sodium lauryl sulfate from the group of anionic surfactants. This is supported by the disclosure at page 6, lines 21-24. It is submitted that the *Wertheim* decision supports an amendment to narrow the "about 10 to about 20" disclosure (regarding alkyl sulfate surfactants) by eliminating the lowest member (C<sub>10</sub>, i.e., lauryl sulfate) from the claimed compositions. This is particularly true in the instant case, wherein the disclosure of the primary reference is, as will be seen from the later discussion herein, self-contradictory.

#### The Wertheim Decision Supports The Claim Amendments

Beginning at the bottom of page 7 of the Office Action of 5/07/03, the Examiner has cited *In re Wertheim*, 541 F2d 257; 191 USPQ 90 (CCPA 1976) for the proposition that, "...where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists."

In regard to the surfactant range issue now recited in the amended claims, it is submitted the *Wertheim* decision also fully supports the amendments presented herewith, which take the amended claims outside the cited 6,025,322 patent, as discussed below. *Wertheim* related to a process patent for making freeze-dried coffee. The issue there was whether the amended claims were entitled to the benefit of the filing date of the Applicants' earlier Swiss application. The answer turned on whether the Swiss application contained written descriptions supporting the claim limitations.

In *Wertheim*, both the Swiss (and parent U.S.) applications disclosed a process involving concentrating the coffee, "...until a concentration of 25-60% of solid matter is reached," and contained examples of embodiments having solids contents of 36% and 50% (541 F2d at 262). The Court pointed out that the inquiry is factual and depends on the nature of the invention and the amount of knowledge imparted by the disclosure to those skilled in the art. Said another way, it must be sufficiently clear to such a person skilled in the art that the Applicants invented the processes, including the limitations, as of the priority date.

The Court stated that an Applicant is entitled to change what he regards as his invention (*ibid* at 263). The court did hold that one group of claims which recited a solids content broader than the disclosed range was not supported and not entitled to the Swiss filing date. However, and relative to the instant case, another group of claims reciting a narrower range of between 35% and 60% was held to be supported by the 25-60% disclosure.

As in *Wertheim*, the specification- plus- working Examples in the present application all support levels of anionic surfactant in the 5% to about 70%, and "at least about 9%", ranges as now recited in Claim 8 (amended) and new Claims 15-18. And, as noted above, there is also full support for the 5% to 70% language in the specification.

In light of the descriptive matter in the specification and the *Wertheim* decision, it is submitted that there is full support for all amendments and entry is requested.

#### Rejections Under 35 USC 112

Claims 1-9 stand rejected, for reasons of record at page 2 of the Office Action. Applicants respectfully traverse the rejections.

The Examiner has noted that only U.S. patents and allowed applications can be incorporated by reference. Accordingly, the Table at page 4 of the application has been amended to update the status of the cited documents. As an aside, it may be arguable whether the cited PCT filings with the U.S. Receiving Office are not, in fact, "U.S. applications" that would be available to the public by virtue of their incorporation by reference in the present application.

In any event, it is submitted that the documents cited in Table 4, as amended, are appropriately incorporated by reference into the application. Accordingly, it is respectfully noted that there is no requirement to incorporate their contents into the specification. Reconsideration and withdrawal of the rejection on this basis are requested.

#### Supplemental IDS/Form PTO SB08

At page 2 of the Office Action, the Examiner questions why the cited documents have not been submitted for consideration in this case. Submitted herewith is a Supplemental IDS, with copies of the documents cited in Table 4, for consideration by the Examiner. It is requested that these documents be formally made of record in the case.

#### Rejections Under 35 USC 102

Claims 1-9 stand rejected as being anticipated by DE 19,643,281 A1 (English version U.S. 6,025,322) for reasons of record at page 3 of the Office Action.

Applicants respectfully traverse the rejections, to the extent they may apply to the amended claims now in the case.

As briefly noted above, the '322 document contains a logical inconsistency. At page 2, lines 63-64, patentees teach a detergent composition which comprises, *inter alia*:

“(ii) 0-4.0% by weight, preferably to 2.5%, of an anionic surfactant”

Again, at page 4, l. 51-53, '322 reasserts the restricted level of anionic surfactant, as follows:

“The detergents are preferably free of anionic surfactants but may contain them as component (ii) in amounts of up to 4% by weight, preferably up to 2.5% by weight.”

Moreover, Examples I-VII and XI-XII would all appear to contain less than the 4% anionic surfactant taught in the above-noted disclosures.

Why the 0-4.0%, preferably to 2.5%, limit on the anionic surfactant?

At column 2, l. 51-54, '322 teaches:

“The condensates to be used according to the invention have a maximum effect at concentrations of as little as from 10 to 100 ppm in the wash or rinse liquor, for example in the absence of anionic surfactants.” [Emphasis supplied]

Again, at Column 7, l. 62-65, '322 teaches:

“The results with polymers 1 and 4 to be used according to the invention show that the polymers have a very good color transfer

inhibiting effect in detergents free of anionic surfactants."

[Emphasis supplied]

Turning, then, to Example IX, one confronts a mystery! After all the discussion, disclosure and demonstrations that the compositions should be free of, or, at most, contain 4%, anionic surfactant, Example IX recites 12% Na lauryl sulfate used in combination with Polymer 1. In view of the clear and repeated teachings of the entire balance of '322, it is submitted that Example IX is an *anomaly* that should be disregarded.

Indeed, it is submitted that a full and fair reading of '322 actually teaches away from the use of greater than 4% anionic surfactants in the compositions, in the manner of the present invention. It is further submitted that the relevant case law supports this position.

As the Examiner is aware, "A prior art reference may be considered to teach away when 'a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.'" *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F. 3d 877, 885, 45 U.S.P.Q. 2d, 1977, 1984 (Fed. Cir. 1998).

Moreover, in *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* 796 F. 2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986) *Cert. denied*, 484 U.S. 823 (1987), the Federal Circuit held that a single line (here, a single number) in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness.

This, it is submitted, is the situation in the present application wherein the cited '322 document apparently contains conflicting disclosure. In any event, and even assuming *arguendo* that the recitation of 12% lauryl sulfate in Example IX is correct, that restrictive disclosure still would have no impact on Claim 1, as now amended, since sodium lauryl sulfate is excluded from the claim. Moreover, Example IX of '322 would clearly have no impact on the new Claims 15-18, presented herewith, relating to alkyl benzene sulfonates and alkyl alkoxy sulfates.

Even assuming *arguendo* that Example IX of '322 means what it says, then, in view of the vast bulk of '322's disclosure, one would have to assume that Na lauryl sulfate is a very special anionic surfactant, indeed.

Again, assuming *arguendo* that Na lauryl sulfate is special, one might easily assume that its relatively short (C<sub>10</sub>) chain length might make it compatible with Polymer 1.

However, even assuming all the above, it is submitted that nothing in '322 would lead one to employ anionic surfactants other than Na lauryl sulfate in the present compositions at the levels now recited in the amended claims. Moreover, nothing therein would teach or suggest the specific surfactants used at the levels recited in new Claims 15-18, now presented herein.

In light of the clear teachings of '322, the amendments presented herein and the self-contradictory Example IX of '322, it is submitted that the rejections under §102 should be reconsidered and withdrawn.

#### Rejections Under 35 USC 103

Claims 1-9 stand rejected under over '322 (above), for reasons of record at page 4 of the Office Action.

Claims 1, 2, 7 and 9 also stand rejected over U.S. 4,371,517, for reasons of record at page 4 of the Office Action.

Applicants respectfully traverse all rejections under §103.

With regard to '322, the Examiner has noted that the claims are obvious because they are anticipated, i.e., that anticipation is the epitome of obviousness.

Applicants' position regarding '322 is as stated above relative to the rejection under §102, and will not be repeated here, for the sake of brevity. Boiled-down, it is this: Read in its entirety, '322 can be fairly said to teach away from the claims as now presented. It is respectfully submitted that teaching away is the epitome of non-obviousness. Reconsideration and withdrawal of the rejection on this basis are requested.


With regard to the '517 document, it is submitted that the disclosures therein neither teach nor suggest the present invention, as now claimed. The '517 document requires "at least one cationic polymer, at least one anionic polymer, at least one alkali metal salt and at least one non-ionic surface active agent or surface-active agent which contains one or more carboxyl or carboxylate groups in addition to non-ionic groups." (Abstract)

It is submitted that nothing in '517 teaches or suggests the use of sulfated or sulfonated anionic surfactants in the manner now claimed. Nothing in '517 suggests that the compositions therein could, or should, be modified to substitute sulfated or sulfonated anionic surfactants for the nonionic/carboxylate surfactants required therein. And, of course, '322 teaches away from the use of such surfactants, at least at the present levels, and adds nothing to '517 in this regard. Accordingly, reconsideration and withdrawal of the rejections on this basis are requested.

In light of the above remarks, it is requested that the Examiner reconsider and withdraw all rejections. Early and favorable action in the case is respectfully requested.

Appl. No. 09/806,881  
Atty. Docket No. 7488  
Amdt. dated 09/04/2003  
Reply to Office Action of 5/7/03  
Customer number 27752

Respectfully submitted,  
Panandiker et al.

By   
Jerry J. Yetter  
Attorney for Applicant(s)  
Registration No. 26,598  
(513) 627-1907

September 4, 2003  
Customer No. 27752